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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/815,883

03/31/2004

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DUQ-002RCE(DEP5290)

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959 7590 05/18/2007  
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EXAMINER

REIMERS, ANNETTE R

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

05/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/815,883

Applicant(s)

KALFAS ET AL.

Examiner

Annette R. Reimers

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006 and 28 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 12,13,19 and 21-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11,14-18,20,27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 6, 2006 has been entered.

### ***Election/Restrictions***

Applicant's election with traverse of Invention I, claims 1-20 and 27 and 28 and Species IV, figures 4A-4E in the reply filed on February 28, 2007 is acknowledged. The traversal is on the ground(s) that the search would not be burdensome on the examiner. This is not found persuasive because "a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification" (see M.P.E.P. § 808.02). In the instant case, as stated in the election/restriction requirement, the inventions have separate classifications. Furthermore, applicant's amendments to the claims require further search and/or consideration. Moreover, regarding the species requirement, species are independent or distinct because the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are

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not obvious variants. See MPEP § 806.05(j). In the instant case, *the inventions as claimed have a materially different design*. In addition, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants. The requirement is still deemed proper and is therefore made FINAL.

Examiner further acknowledges that applicant believes that claims 1-20, 27 and 28 read on the elected Species, i.e. figures 4A-4E. Examiner agrees with applicant except for claims 12, 13 and 19. Claims 12 and 19 require a spherical bushing, disclosed in figure 8, which was not elected by applicant. In addition, claim 13 requires a top loading screw for securing both the first rod and the second rod, disclosed in figure 8, which was not elected by applicant. Examiner also acknowledges that applicant believes that claims 1, 8, 27 and 28 are generic to all species. Examiner agrees with applicant that claims 1, 8, 27 and 28 appear to be generic to all species.

Claims 12, 13, 19 and 21-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 28, 2007.

### **Specification**

The disclosure is objected to because of the following informalities: On page 10, line 5, there appear to be a typographical error. The external teeth should be 386 and 387 not 381 and 383. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-11, 14-18, 20, 27 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Shitoto (US Patent Number 6,716,213).

Shitoto discloses various embodiments of a connector for connecting a first spinal rod, e.g. 15, and a second spinal rod, 15, comprising a first housing component, e.g. 10, for connecting a first spinal rod and a second housing component, e.g. 10, for connecting a second spinal rod, the housing component defining a first bore hole, e.g. 11 or 21, for receiving a portion of the first rod, the first bore hole extending along a first longitudinal axis and a second bore hole, e.g. 11 or 21, for receiving a portion of the second rod, the second bore hole extending along a second longitudinal axis and a locking element, e.g. 25, for securing one of the first rod within the first bore hole and the second rod within the second bore hole, wherein the first longitudinal axis is configured to be variably offset in a sagittal plane from the second longitudinal axis by a variable predetermined offset distance when the connector is implanted in a patient (see embodiments of figures 1-9). The second housing component includes a coupling rod, e.g. 12 or 22, extending in a direction that is transverse to the second bore hole and the

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first housing component includes a coupling hole (see figure 9) configured to receive the coupling rod. The connector further comprises a clamping mechanism, 48 and 52, for securing the first housing component in a selected position relative to the second housing component.

With regard to statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Shitoto, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shitoto (US Patent Number 6,716,213) in view of Olerud et al. (US Patent Number 5,053,034), previously cited by examiner on 892.

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Shitoto discloses the claimed invention except the coupling rod including a first set of teeth on an outside surface and the coupling hole including a second set of teeth on an inside surface. Olerud et al. disclose a coupling rod including a first set of teeth on an outside surface, e.g. 19, and the coupling hole including a second set of teeth on an inside surface, e.g. 9 (see figure 7) and teach such an interlocking arrangement for effective locking (see column 3, line 56-59). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Shitoto with interlocking teeth, in view of Olerud et al., to effectively lock the connector.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-11, 14-18, 20, 27 and 28 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER